

REMARKS

This Amendment and Request for Reconsideration is submitted in response to an outstanding Office Action dated October 25, 2006, the shortened statutory period for response set to expire on January 25, 2007. A petition for an extension of time is included herewith.

I. Status of the Claims

Please amend claims 1, 10-14, and 21-24, and add new claims 25 and 26 as indicated above. Support for new claims 25 and 26 is found in a non-limiting example at page 19, lines 10-11. Claims 1-26 are now pending in the application. Claims 1, 10, 11, 12, 13, 14, 21, 22, 23, and 24 are independent claims.

Applicant acknowledges the Examiner's citation of statutory authority as a basis for claim rejections.

II. Rejections under 35 U.S.C. § 101

The Examiner has rejected claim 11 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Although not rejected in the Office Action, applicant presumes that the Examiner intended to apply the same rejection to pending claim 21, which is also directed to computer executable software code transmitted as an information signal. Applicant respectfully traverses the rejection.

Applicant submits that in software sale and distribution, code for accomplishing a method may be sold and distributed on a computer readable medium (*e.g.*, claims 12 and 23) for later installation on a computer system. It is also common for software code to be distributed directly to users by electronic down-load to a computer, without transfer of a computer readable medium. In order to fully protect the various types of sales and distribution activities, applicants have crafted claims to specifically cover electronic transfer of infringing software code, by

directing claims 11 and 22 to computer software code **transmitted as an information signal**.

Applicants submit that computer executable software code transmitted as an information signal (claims 11 and 22) serves a useful purpose just as a computer readable medium (claims 12 and 23), and a computer with memory and a processor (claims 13 and 24) serve useful purposes. Applicant submits that to be statutory, 35 U.S.C. § 101 requires nothing more. For this reason, applicant requests withdrawal of the rejection of claim 11.

Applicant also directs the Examiner's attention to claims 84, 85 and 86 of U.S. Patent No. 6,513,020, which issued on January 28, 2003 ("the '020 patent"). Those claims are directed to "A computer data signal embodied in a carrier wave and representing instructions for execution by a computer for ..." Applicant's also direct the Examiner's attention to claims 82 and 83 of the '020 patent. Those claims are directed to a computer program product for ... comprising: a computer readable medium having stored thereon ..." Applicants submit that there is no statutory difference between the subject matter of those claims of the '020 patent and claims 11 and 22 of the instant application.

Finally, Applicant directs the Examiner's attention to recent holdings from the Court of Appeals for the Federal Circuit, which clearly show that software code alone is patentable as a process, and that electronic transmission of software code is eligible for the same protection as a physical media where the software code is stored. In *Eolas*, the Federal Circuit stated that "[w]ithout question, **software code alone qualifies as an invention eligible for patenting ... at least as processes**. ... [T]his software code claimed in conjunction with a physical structure, such as a disk, fits within at least these ... categories of subject matter within the broad statutory label of 'patented invention.'" *Eolas Tech. Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1399 (Fed. Cir. 2005) (emphasis added). In *A T & T*, the Federal Circuit quoted *Eolas* for

that proposition, and then stated “we cannot accept [the] suggestion that **software sent by electronic transmission must be treated differently** for purposes of § 271(f) liability **from software shipped on disks, ... as it would amount to an exaltation of form over substance.** [W]hether software is sent abroad via **electronic transmission or** shipped abroad on a ... **disk is a distinction without a difference** for the purposes of § 271(f) liability.” *A T & T Corp. v. Microsoft Corp.*, No. 04-1285, 2005 WL 1631112, *4 (Fed. Cir.(S.D.N.Y) July 13, 2005) (emphasis added).

Withdrawal of the rejection of claim 11 under 35 U.S.C. § 101 is respectfully requested.

III. Rejections under 35 U.S.C. § 102

The Examiner has rejected claims 1-14 under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 6,067,639 to Rodrigues et al. (“*Rodrigues*”). With respect to independent claims 1 and 10-14, the Examiner cites to particular portions of *Rodrigues* in the abstract and columns 2-4. Applicant respectfully traverses the rejection. The Examiner points to column 4, lines 16-36 of *Rodrigues* as disclosing convert the input file to another file format or data structure. Applicant is unable to find any disclosure or teaching in the cited section of *Rodrigues* for that claim element. Accordingly, applicant submits that the rejection under § 102 is improper in view of *Rodrigues*. However to more clearly define the claimed inventions, applicant has amended independent claims 1 and 10-14 to recite convert the input file to a file format or data structure substantially common to the plurality of jobs. Support for the amendment is found in a non-limiting example at page 19, lines 10-11. This additional distinction is also not found in *Rodrigues*, and for that reason applicant submits claims 1-14 are allowable over *Rodrigues*.

IV. Rejections under 35 U.S.C. § 103

The Examiner has rejected claims 15-24 under 35 U.S.C. § 102 as being unpatentable over *Rodrigues* in view of “applicant’s choice of selecting the delivery method of data.” The Examiner states the feature is considered a choice of design and merely a selection not related to the development of the software application. Applicant respectfully traverses the rejection. Claims 14-20 are directed to methods for processing a data file, not methods for software application development as in claims 1-10. Therefore, the choice of delivery method in claims 14-20 is not merely a choice of design. It is related to the method for processing a data file. Further, there is nothing inherent or obvious in the “choice of delivery method” recited in claims 15-17, and applicant submits that the Examiner has not made the required prima facie case for obviousness. Accordingly withdrawal of the rejection as to claims 15-24 at least for that reason is requested.

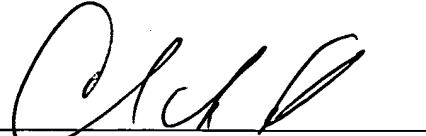
In addition, independent claims 21-24 have been amended and for reasons similar to the reasons provided above with respect to claim 1, *Rodrigues* does not disclose or suggest all of the elements, and claims 21-24 are therefore allowable over *Rodrigues*.

V. Request for Reconsideration

Applicant respectfully submits that the claims of this application are in condition for allowance. Accordingly, reconsideration of the rejection and allowance is requested. If a conference would assist in placing this application in better condition for allowance, the undersigned would appreciate a telephone call at the number indicated.

PATENT
Docket No.: 37799.00200

Respectfully submitted,
Milbank, Tweed, Hadley & McCloy LLP

A handwritten signature in black ink, appearing to read "Chris L. Holm", written over a horizontal line.

Chris L. Holm
Reg. No.: 39,227

January 29, 2007

Milbank Tweed Hadley & McCloy LLP
1 Chase Manhattan Plaza
New York, NY 10005
(212) 530-5000 / (212) 530-5219 (facsimile)